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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/606,439

06/26/2003

Subodh K. Raniwala

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06/13/2008

BANNER & WITCOFF, LTD.

and ATTORNEYS FOR CLIENT NO. 006943

10 SOUTH WACKER DR.

SUITE 3000

CHICAGO, IL 60606

EXAMINER

ELOSHWAY, NIKI MARINA

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

06/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------------|--|
| Office Action Summary | Application No. 10/606,439 | Applicant(s) RANIWALA, SUBODH K. | |
| | Examiner NIKI M. ELOSHWAY | Art Unit 3781 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-43 and 58-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-38, 41, 43, 58, 60-63, 65-67 and 69 is/are rejected.
- 7) ☒ Claim(s) 39, 40, 42, 59, 64, 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 31, 2008 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 63 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Zingle et al. (U.S. 5,596,814). Zingle teaches a container discussed in Example 4, having a body (the large stopper), with a through going hole, a closure capping the body (the overcap), a membrane 14 and an air tight seal (the smaller stopper).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3781

5. Claims 30-38, 41, 43, 58, 60-62 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (U.S. 5,522,155) in view of Zingle et al. (U.S. 5,596,814). Jones teaches a container 1, 10 having a body 1 and a closure 10. The closure has a through going hole 14, with a hydrophobic membrane 30 secured to the inner end and an air tight seal closing the outer end.

Jones teaches the claimed invention except for the air tight seal being permanently attached. Zingle et al. teach that it is known to provide a container with an air tight seal which is permanently attached to the closure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container of Jones with the air tight seal being permanently attached to the closure, as taught by Zingle et al., in order to prevent venting once initial venting is complete.

Regarding claims 38, 41 and 43, the modified device of Jones teaches the claimed invention except for the coating or adhesive of the seal. Zingle et al. teach that it is known to provide a container with coating on a seal (see col.5 lines 41-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container of Jones with the air tight seal having a coating/adhesive, as taught by Zingle et al., in order to securely fasten the seal within the opening and create an adhesive bond between the seal and closure.

Regarding claims 31, 61 and 67, Jones teaches the claimed invention except for the air tight seal terminating flush with the outer surface of the closure. Zingle et al. teach that it is known to provide a container with an air tight seal which terminates flush with the outer surface of the closure (see element 24 which is seated within element 22 of the closure). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container of Jones with the air tight seal terminating flush with the outer surface of the closure, as taught by Zingle et al., in order to securely fasten the seal within the opening and prevent unintentional removal of the seal.

Regarding claim 37, it further would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the container of Jones with the hole being between 50 and 100

Art Unit: 3781

microns, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

6. Claims 39, 40, 42, 59, 64 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed March 31, 2008 have been fully considered but they are not persuasive. Applicant argues that neither Jones nor Zingle teach "an air tight seal permanently closing the outer end of the hole". Jones is modified in the rejection by Zingle to teach permanent attachment of the seal to the closure. Zingle discloses throughout the patent that the small stopper 24 forms a hermetic seal after venting when in the lower/applied position. In Example 3 of Zingle, an overcap is provided to secure the stopper to the vial. The overcap locks the smaller stopper into the recess of the larger stopper and secures the hermetic seal. In Example 4, Zingle discloses that the smaller stopper is driven into the larger stopper to form a hermetic seal "which could be further secured and overcapped" (col. 8 lines 9-10). These teachings show that the smaller stopper of Zingle is permanently secured into the recess of the larger stopper, and the connection is considered permanent, to the degree set forth in the claims.

8. Applicant's arguments with respect to claims 63 and 65-67 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3781

Conclusion

9. **THIS ACTION IS MADE NON-FINAL.**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niki M. Eloshway whose telephone number is 571-272-4538. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Niki M. Eloshway/
Niki M. Eloshway
Examiner
Art Unit 3781

nme